

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

TERADA et al

Serial No. 10/062,541

Filed: February 6, 2002

For: MEMORY WRITING DEVICE FOR AN ELECTRONIC
DEVICE

Atty. Ref.: 2018-505

Group: 2186

Examiner: Tran, D.

* * * * *

November 25, 2002

Assistant Commissioner for Patents
Washington, DC 20231

REQUEST FOR REFUND

Sir:

A refund is respectfully requested for the erroneous charge of \$180.00 on Account No. 14-1140 (Posting Ref. TXT 10062541) for the submission of an Information Disclosure Statement (Fee Code 126). A copy of the deposit account statement for Account No. 14-1140 citing Posting Ref. TXT 10062541 is attached.

An Information Disclosure Statement (IDS) was filed on August 26, 2002 as part of an Election/Response. At the time the IDS was filed, an action on the merits of the application had not yet been issued. Accordingly, no fee is due for consideration of the IDS. That is, at the time the IDS was filed, only a Restriction Requirement had been issued. As discussed in MPEP §609, a Restriction Requirement does not constitute an action on the merits. (See the selected portion of MPEP §609 attached hereto.) The IDS was therefore filed before an action on the merits of this application had been issued.

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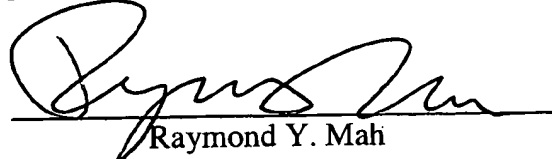
TERADA et al
Serial No. 10/062,541

Since no fee is due for consideration of the IDS, Applicant respectfully requests that \$180 for consideration of the IDS be refunded to Applicant's undersigned attorney by crediting \$180.00 to account no. 14-1140 under Order No. 2018-505.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:


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Reg. No. 41,426

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Requested Statement Month: September 2002
 Deposit Account Number: 141140
 Name: NIXON & VANDERHYE P.C.
 Attention: LENARD MITCHARD
 Address: 1100 N GLEBE ROAD
 City: ARLINGTON
 State: VA
 Zip: 22201-4714

DATE	SEQ	POSTING REF TXT	ATTORNEY DOCKET NBR	FEE CODE	AMT	BAL
09/03	78	10088678	4161-2 ARC	704	-\$510.00	\$17,440.98
09/03	87	10031387	39-254 MJW	704	-\$510.00	\$17,950.98
09/03	393	PCT/US01/45110	3691-329 JAR	191	\$260.00	\$17,690.98
09/04	1	09542933	11-889 DMB	102	-\$84.00	\$17,774.98
09/04	3	09674361	604-576 LCM	116	\$290.00	\$17,484.98
09/04	4	10062541	2018-505 LSN	126	\$180.00	\$17,304.98
09/04	7	09937714	620-162 BJS	966	-\$252.00	\$17,556.98
09/04	28	09201389	2380-83 JRL	704	-\$320.00	\$17,876.98
09/04	30	10110960	39-261 MJW	704	-\$510.00	\$18,386.98
09/04	30	09201389	2380-83 JRL	704	-\$320.00	\$18,706.98
09/05	2	09736843	839-827 MK	704	-\$300.00	\$19,006.98
09/05	43	09249785	2380-14	102	-\$168.00	\$19,174.98
09/05	44	09249785	2380-14 HNB	102	\$84.00	\$19,090.98
09/05	273	09341551	117-292 GRT	561	\$15.00	\$19,075.98
09/06	1	09457139	3579-2	202	\$42.00	\$19,033.98
09/06	2	09457139	3579-2 RAM	203	\$27.00	\$19,006.98
09/06	40	* 1954165		381	\$100.00	\$18,906.98
09/06	73	10234200	1035-386 HNB	102	\$84.00	\$18,822.98
09/06	102	10233605	925-242 HNB	102	\$84.00	\$18,738.98
09/06	124	09534112	263-2784 MIL	704	-\$3.00	\$18,741.98
09/06	127	09694572	3704-5 MIL	704	-\$6.00	\$18,747.98
09/09	1	10160236	* 1179-50 LSN	102	-\$84.00	\$18,831.98
09/09	8	09750099	620-127 MJW	116	\$400.00	\$18,431.98
09/09	28	10234465	2751-16 BHD	104	\$280.00	\$18,151.98
09/09	35	09529629	3325-26 JSP	704	-\$460.00	\$18,611.98

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Likewise, an information disclosure statement will be considered if it is filed later than 3 months after the application filing date but before the mailing date of a first Office action on the merits. An action on the merits means an action which treats the patentability of the claims in an application, as opposed to only formal or procedural requirements. An action on the merits would, for example, contain a rejection or indication of allowability of a claim or claims rather than just a restriction requirement (37 CFR 1.142) or just a requirement for additional fees to have a claim considered (37 CFR 1.16(d)). Thus, if an application was filed on January 2 and the first Office action on the merits was not mailed until 6 months later on July 2, the examiner would be required to consider any proper information disclosure statement filed prior to July 2.

(b) RCE and CPA

The 3-month window as discussed above does not apply to a RCE filed under 37 CFR 1.114 or a CPA filed under 37 CFR 1.53(d). An IDS filed after the filing of a RCE will be considered if the IDS is filed before the mailing date of a first Office action on the merits. A RCE is not the filing of an application, but merely the continuation of prosecution in the current application. After the mailing of a RCE, such application is treated as an amended application by the examiner and is subject to a short turnover time. Therefore, applicants are encouraged to file any IDS with the filing of a RCE. See MPEP § 706.07(h) for details on RCEs.

Similarly, an IDS filed in a CPA will be considered if the IDS is filed before the mailing date of a first Office action on the merits. Applicants are encouraged to file any IDS in a CPA as early as possible, preferably at the time of filing of the CPA request.

If an IDS cannot be filed before the mailing of a first Office action on the merits (generally within 2 months from the filing of the RCE or CPA), applicants may request a 3-month suspension of action under 37 CFR 1.103(c) in an application at the time of filing of the RCE, or under 37 CFR 1.103(b) in a CPA, at the time of filing of the CPA. Where an IDS is mailed to the Office shortly before the expiration of a 3-month suspension under 37 CFR 1.103(b) or (c),

applicant is requested to make a courtesy call to notify the examiner as to the IDS submission.

B (2) Information Disclosure Filed After B(1) but BEFORE Mailing of Final Action, Notice of Allowance, or an *Ex parte* Quayle Action (37 CFR 1.97(c))

An information disclosure statement will be considered by the examiner if filed after the period specified in subsection III.B(1) above, but prior to the date the prosecution of the application closes, i.e., before (not on the same day as the mailing date of any of the following:

- a final action under 37 CFR 1.113, e.g., final rejection;
 - a notice of allowance under 37 CFR 1.311; or
 - an action that closes prosecution in the application, e.g., an *Ex parte* Quayle action,
- whichever occurs first, provided the information disclosure statement is accompanied by either (1) a statement as specified in 37 CFR 1.97(e) (see the discussion in subsection III.B(5) below); or (2) the fee set forth in 37 CFR 1.17(p). If a final action, notice of allowance, or an *Ex parte* Quayle action is mailed in an application and later withdrawn, the application will be considered as not having had a final action, notice of allowance, or an *Ex parte* Quayle action mailed for purposes of considering an information disclosure statement.

An *Ex parte* Quayle action is an action that closes the prosecution in the application as referred to in 37 CFR 1.97(c). Therefore, an information disclosure statement filed after an *Ex parte* Quayle action, must comply with the provisions of 37 CFR 1.97(d).

(a) Information is Used in a New Ground of Rejection

i) Final Rejection is Not Appropriate

If information submitted during the period set forth in 37 CFR 1.97(c) with a statement under 37 CFR 1.97(e) is used in a new ground of rejection on unamended claims, the next Office action will not be made final since in this situation it is clear that applicant has submitted the information to the Office promptly after it has become known and the information is being submitted prior to a final determination on patentability by the Office.